

**REMARKS**

Reconsideration and allowance of the subject application in view of the foregoing amendments and the following remarks is respectfully requested. Entry of this Amendment under Rule 116 is merited as it raises no new issues and requires no further search.

Claims 2-6, 9-10 and 12-13 are pending in the application. Claims 1, 7, 8, and 11 have been cancelled without prejudice or disclaimer. No new matter has been introduced through the foregoing amendments.

The 35 U.S.C. 112, *second paragraph* rejection of claim 11 is moot as claim 11 has been canceled.

**Rejection of claims 2, 3, 12 and 13 under 35 U.S.C 102(b) as being anticipated by Peterson (US 2003/0157762).**

**As to claim 2**

Application respectfully submits that the claimed steps “printing ink marks by transferring ink from a printing device onto the exposed backside surfaces of the dice” and “curing the ink marks on the dice “in combination are not disclosed in Peterson. Peterson discloses in Fig. 2 and paragraph [0038] that the marking medium 120 can then be cured to strengthen the bond between the adhesive 136 and the wafer 100....After curing the marking medium 120, the strength of the bond between the wafer 100 and the underlying contrast film 132 is increased to be greater than the strength of the bond between the outer contrast film 134 and the transfer medium 150. In other words, Peterson discloses that the marking medium 120 is cured to strengthen the bond between the adhesive 136 and the wafer 100 before ink marks are formed on the dice. In contrast, the claimed curing step is required to be performed after ink marks have been formed on the dice by a printing device. Peterson clearly fails to teach or suggest the claimed steps in combination. Claim 2 is therefore distinguishable from Peterson and is not anticipated by

Peterson.

**As to claims 3, 12, and 13**

Claims 3, 12 and 13 depend from claim 2 and are considered patentable at least for the reasons advanced with respect to claim 2. Claim 3 is also patentable on its own merits since this claim recites other features neither disclosed, taught nor suggested by the applied art.

For example, the claim 3 further comprises the step of removing defective ink marks after the printing step and before the curing step. Peterson discloses in paragraph [0038 that before curing the marking medium 120, the bond between the wafer 100 and the underlying contrast film 132 formed by the adhesive 136 is preferably weaker than the bond between the outer contrast film 134 and the transfer medium 150. As a result, the marking medium 120 may be tacked onto the wafer 100 and then removed if there are any wrinkles or air pockets between the marking medium 120 and the wafer 100. Furthermore, the marking medium 120 is cured before ink marks are formed on the dice. Note the discussion *supra* with respect to claim 1. Therefore, the step of removing wrinkles or air pockets in Peterson is performed before both the printing step and curing step. Peterson clearly fails to teach or suggest the claimed step of removing defective in marks after the printing step and before the curing step.

**Rejection of claims 1, 7 and 8 under 35 U.S.C. 103(a) as being unpatentable over Peterson in view of Kim (US 6,187,615).**

Claims 1, 7 and 8 have been cancelled. The rejection is therefore moot.

**Rejection of claims 4-6 under 35 U.S.C. 103(a) as being unpatentable over Peterson in view of Schramm (US 2004/0060910), hereinafter Schramm.**

**As to claims 4-6**

Claims 4-6 depend from claim 2 and hence include all the limitations of claim 2. Claims 4-

6 are thus patentable for the reasons presented above with respect to claim 2. In addition, Peterson does not disclose how to position the wafer in order to print ink marks at predetermined locations on the backside surfaces of the dice at all.

Furthermore, Applicant wishes to direct the Examiner's attention to the basic requirements of a prima facie case of obviousness set forth in MPEP, section 2143, where it is stated that to establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine the reference teachings. Second, there must be reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.

Therefore, in the absence of any teaching or suggestion to combine Peterson with Schramm, it is apparent that the Examiner has impermissibly used the Applicant's disclosure as guidance to hunt through the prior art for the claimed positioning steps.

For any of the reasons advanced above, claims 4-6 are patentable over the applied references.

**Rejection of claims 9-11 under 35 U.S.C. 103(a) as being unpatentable over Peterson in view of Grigg (US 6,703,105), hereinafter Grigg.**

**As to claims 9-10**

Claims 9-10 depend from claim 2 and are considered patentable at least for the reasons advanced with respect to claim 2.

Accordingly, Applicants respectfully submit that all pending claims in the present application are now in condition for allowance. Early and favorable indication of allowance is courteously solicited.

The Examiner is invited to telephone the undersigned, Applicant's attorney of record, to facilitate advancement of the present application.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 07-1337 and please credit any excess fees to such deposit account.

Respectfully submitted,

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